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EXAMINER

CHEN, CHONGSHAN

ART UNIT	PAPER NUMBER
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2172

DATE MAILED: 10/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/788,388

Applicant(s)

OKADA ET AL.

Examiner

Chongshan Chen

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 23 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-36,38-73 and 75-78 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-36,38-73 and 75-78 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. This action is responsive to communications: Amendment A, filed on 23 July 2003. This action is made final. Claims 1-36, 38-73 and 75-78 are pending; claims 37, 74 and 79 are cancelled.

#### ***Response to Arguments***

2. Applicant's arguments with respect to claims 1-36, 38-73 and 75-78 have been considered but are moot in view of the new ground(s) of rejection.

#### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-9, 11-17, 19, 27-31, 33, 35-36, 38-46, 48-53, 55-56, 64-68, 70, 72-73, 75-76 and 78 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katariya et al. ["Katariya", 6,473,753 B1] in view of Norihiko (JP 11-242545).

As per claim 1, Katariya discloses a message transmitting and receiving apparatus comprising:

a memory, storing keywords associated with said apparatus and degrees of importance of said keywords (Katariya, Fig. 1, 111, Memory, Fig. 2, 206, store weight in Term Document Weight Matrix);

a detector, detecting an occurrence of a transmitted or received document; an extractor, in response to the detection of an occurrence of a received document, extracting a keyword from said received document; importance determiner unit, determining a degree of importance of said extracted keyword and updating said keywords and said degrees of importance in said memory means (Katariya, col. 3, lines 3-26, “an embodiment of the present invention provides a weighting system for calculating the weight for a term within one document”); and

an indicator providing an indication of the occurrence of said extracted keyword within said received message in accordance with the determined degree of importance of said extracted keyword (Katariya, Fig. 1).

Katariya discloses determining degree of importance of a keyword from document, but does not explicitly disclose determining degree of importance of a keyword from a message. Norihiko discloses extract important keywords from a message (Norihiko, [0010]-[0013]). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Norihiko with Katariya in order to extract important keywords form a message so that a chat participant can hold the flow of the talk easily.

Katariya discloses determining importance of a keyword, but Katariya does not explicitly disclose the determination process is dynamic. Norihiko teaches dynamically determining a degree of importance of a keyword extracted from a message (Norihiko, [0018]-[0025], the applicant’s dynamic determination process is depending on how a user responds to the received messages. Norihiko’s system also depends on the user’s response to determine whether a keyword is important. Only those keywords specified by the user are considered important). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention

was made to combine Norihiko with Katariya in order to extract keywords which the user think them are important.

As per claim 2, Katariya and Norihiko teach all the claimed subject matters as discussed in claim 1, and further teach providing at least one of visual and audio indications of an occurrence of said extracted keyword in a manner determined by a degree of importance of said extracted keyword (Katariya, Fig. 1, Norihiko, [0005]).

As per claim 3, Katariya and Norihiko teach all the claimed subject matters as discussed in claim 1, and further teach a deleting unit to delete a keyword having a degree of importance lower than a threshold value (Norihiko, [0022]).

As per claim 4, Katariya and Norihiko teach all the claimed subject matters as discussed in claim 1, and further teach storing a new keyword extracted from a received message in said memory together with a degree of importance of said new keyword (Katariya, Fig. 1 & 2, Norihiko, [0018]).

As per claim 5, Katariya and Norihiko teach all the claimed subject matters as discussed in claim 1, and further teach said extractor extracts also a candidate keyword from a received message, and said apparatus further comprises a register, storing in said memory, a candidate keyword as a keyword, together with a degree of importance of the candidate keyword, when a user of the apparatus responds to received message data containing the candidate keyword within a predetermined range (Katariya, Fig. 1 & 2, col. 3, lines 3-26, Norihiko, [0019]).

As per claim 6, Katariya and Norihiko teach all the claimed subject matters as discussed in claim 5, except for explicitly disclosing said predetermined range is a predetermined number of messages. However, Norihiko discloses said predetermined range is a predetermined number

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of lines (Norihiko, [0019]). In the real-time chat system of Norihiko, usually one line is one message. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to set the predetermined range as a predetermined number of messages in order to extract keywords from previous messages.

As per claim 7, Katariya and Norihiko teach all the claimed subject matters as discussed in claim 5, and further teach said predetermined range is a predetermined number of lines (Norihiko, [0019]).

As per claim 8, Katariya and Norihiko teach all the claimed subject matters as discussed in claim 5, except for explicitly disclosing said predetermined range is a predetermined number of words. However, Norihiko discloses said predetermined range is a predetermined number of lines (Norihiko, [0019]). The user would like to set the predetermined range as a predetermined number of words in order to further narrow the range. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to set the predetermined range as a predetermined number of words in order to define how many words the user wants to review.

As per claim 9, Katariya and Norihiko teach all the claimed subject matters as discussed in claim 5, except for explicitly disclosing said predetermined range is a predetermined number of characters. However, Norihiko discloses said predetermined range is a predetermined number of lines (Norihiko, [0019]). The user would like to set the predetermined range as a predetermined number of characters in order to further narrow the range. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to set the

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predetermined range as a predetermined number of characters in order to define how many characters the user wants to review.

As per claim 11, Katariya and Norihiko teach all the claimed subject matters as discussed in claim 5, except for explicitly disclosing said message data within a predetermined range are messages received consecutively from a same client. However, the purpose of Norihiko's invention is for a chat participant to be able to hold the flow of the talk easily with another user. It is obvious the messages are received from a same client. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to receive messages from a same client in order to concentrate on the chat with the same user.

As per claim 12, Katariya and Norihiko teach all the claimed subject matters as discussed in claim 1, and further teach determining a degree of importance of a keyword stored in said memory, depending on whether a user of the apparatus has responded to a received message containing said keyword (Norihiko, [0018]-[0019]).

As per claim 13, Katariya and Norihiko teach all the claimed subject matters as discussed in claim 1, and further teach determining a degree of importance of a keyword stored in said memory, depending on whether a user of the apparatus has responded to a received message containing said keyword within a predetermined range (Norihiko, [0018]-[0022]).

Claims 14 and 28 are rejected on grounds corresponding to the reasons given above for claim 6.

Claim 15 is rejected on grounds corresponding to the reasons given above for claim 7.

Claims 16-17 and 30-31 are rejected on grounds corresponding to the reasons given above for claims 8-9.

Claims 19 and 33 are rejected on grounds corresponding to the reasons given above for claim 11.

As per claim 27, Katariya and Norihiko teach all the claimed subject matters as discussed in claim 1, and further teach determining a degree of importance of a keyword in accordance with the number of occurrences of the keyword in a predetermined range of received message data (Norihiko, [0018]-[0022]).

Claim 29 is rejected on grounds corresponding to the reasons given above for claim 7.

As per claim 35, Katariya and Norihiko teach all the claimed subject matters as discussed in claim 1, and further teach determining a degree of importance of a keyword in accordance with an attribute of a received message containing the keyword (Norihiko, [0010]-[0015]).

As per claim 36, Katariya and Norihiko teach all the claimed subject matters as discussed in claim 35, and further teach the attribute of said received message is a network, a channel or a client (Norihiko, [0010]-[0015]).

Claims 38-46 are rejected on grounds corresponding to the reasons given above for claims 1-9.

Claim 48 is rejected on grounds corresponding to the reasons given above for claim 11.

Claims 49-53 are rejected on grounds corresponding to the reasons given above for claims 13-17.

Claim 55 is rejected on grounds corresponding to the reasons given above for claim 19.

Claim 56 is rejected on grounds corresponding to the reasons given above for claim 12.

Claims 64-68 are rejected on grounds corresponding to the reasons given above for claims 27-31.



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Claim 70 is rejected on grounds corresponding to the reasons given above for claim 33.

Claims 72-73 are rejected on grounds corresponding to the reasons given above for claims 35-36.

Claim 75 is rejected on grounds corresponding to the reasons given above for claim 1.

Claim 76 is rejected on grounds corresponding to the reasons given above for claim 13.

Claim 78 is rejected on grounds corresponding to the reasons given above for claim 35.

5. Claims 10, 18, 20-26, 32, 34, 47, 54, 57-63, 69, 71 and 77 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katariya et al. ["Katariya", 6,473,753 B1] in view of Norihiko (JP 11-242545) and further in view of Hideaki et al. ("Hideaki", JP 05-307569).

As per claim 10, Katariya and Norihiko teach all the claimed subject matters as discussed in claim 5, except for explicitly disclosing said predetermined range is a predetermined time period. Hideaki teaches said predetermined range is a predetermined time period (Hideaki, [0010]). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Hideaki with Katariya and Norihiko in order to choose important information over a time period given by the user.

Claim 18 is rejected on grounds corresponding to the reasons given above for claim 10.

As per claim 20, Katariya and Norihiko teach all the claimed subject matters as discussed in claim 1, except for explicitly disclosing changing a degree of importance of a keyword for a predetermined time period after an occurrence of a transmitted message from a user of the apparatus. Hideaki teaches changing a degree of importance of a keyword for a predetermined time period after an occurrence of a transmitted message from a user of the apparatus (Hideaki, [0010]-[0011]). Therefore, it would have been obvious to one of ordinary skill in the art at the

time the invention was made to combine Hideaki with Katariya and Norihiko in order to update the weight of the keyword during the time period.

As per claim 21, Katariya and Norihiko teach all the claimed subject matters as discussed in claim 1, except for explicitly disclosing lowering a degree of importance of a keyword for a predetermined time period after an occurrence of a transmitted message from a user of the apparatus. Hideaki teaches lowering a degree of importance of a keyword for a predetermined time period after an occurrence of a transmitted message from a user of the apparatus (Hideaki, [0010]-[0011]). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Hideaki with Katariya and Norihiko in order to update the weight of the keyword during the time period.

As per claim 22, Katariya and Norihiko teach all the claimed subject matters as discussed in claim 1, except for explicitly disclosing changing a degree of importance of a keyword during a time period when a user of the apparatus is operating an input device of the apparatus and during a predetermined time period after the user stops operating the input device. Hideaki teaches changing a degree of importance of a keyword during a time period when a user of the apparatus is operating an input device of the apparatus and during a predetermined time period after the user stops operating the input device (Hideaki, [0010]-[0011]). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Hideaki with Katariya and Norihiko in order to update the weight of the keyword during the time period.

As per claim 23, Katariya and Norihiko teach all the claimed subject matters as discussed in claim 1, except for explicitly disclosing lowering a degree of importance of a keyword during

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a time period when a user of the apparatus is operating an input device of the apparatus and during a predetermined time period after the user stops operating the input device. Hideaki teaches lowering a degree of importance of a keyword during a time period when a user of the apparatus is operating an input device of the apparatus and during a predetermined time period after the user stops operating the input device (Hideaki, [0010]-[0011]). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Hideaki with Katariya and Norihiko in order to update the weight of the keyword during the time period.

As per claim 24, Katariya and Norihiko teach all the claimed subject matters as discussed in claim 1, except for explicitly disclosing determining a degree of importance of a keyword according to schedule data of a user of the apparatus. Hideaki teaches determining a degree of importance of a keyword according to schedule data of a user of the apparatus (Hideaki, [0010]-[0011]). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Hideaki with Katariya and Norihiko in order to update the weight of the keyword during the time period.

As per claim 25, Katariya and Norihiko teach all the claimed subject matters as discussed in claim 1, except for explicitly disclosing raising a degree of importance of a keyword according to schedule data of a user of the apparatus. Hideaki teaches raising a degree of importance of a keyword according to schedule data of a user of the apparatus (Hideaki, [0010]-[0011]). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Hideaki with Katariya and Norihiko in order to update the weight of the keyword during the time period.

As per claim 26, Katariya and Norihiko teach all the claimed subject matters as discussed in claim 1, except for explicitly disclosing said importance determiner unit sets, in accordance with a time period, a keyword and a degree of importance thereof designated by a user of said apparatus, the degree of importance of said keyword effective during said time period. Hideaki teaches importance determiner unit sets, in accordance with a time period, a keyword and a degree of importance thereof designated by a user of said apparatus, the degree of importance of said keyword effective during said time period (Hideaki, [0010]-[0011]). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Hideaki with Katariya and Norihiko in order to update the weight of the keyword during the time period.

Claim 32 is rejected on grounds corresponding to the reasons given above for claim 10.

As per claim 34, Katariya and Norihiko teach all the claimed subject matters as discussed in claim 1, except for explicitly disclosing lowering a degree of importance of a keyword when the number of occurrences of the keyword in received message data within a predetermined time period exceeds a predetermined number. Hideaki teaches lowering a degree of importance of a keyword when the number of occurrences of the keyword in received message data within a predetermined time period exceeds a predetermined number (Hideaki, [0036]-[0057]). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Hideaki with Katariya and Norihiko in order to update the weight of the keyword during the time period.

Claim 47 is rejected on grounds corresponding to the reasons given above for claim 10.

Claim 54 is rejected on grounds corresponding to the reasons given above for claim 18.

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Claims 57-63 are rejected on grounds corresponding to the reasons given above for claims 20-26.

Claim 69 is rejected on grounds corresponding to the reasons given above for claim 32

Claim 71 is rejected on grounds corresponding to the reasons given above for claim 34.

Claim 77 is rejected on grounds corresponding to the reasons given above for claim 26.

### ***Conclusion***

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

### ***Contact Information***


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chongshan Chen whose telephone number is (703) 305-8319.

The examiner can normally be reached on Monday - Friday (8:00 am - 4:30 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Y Vu can be reached on (703)305-4393. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-3900.

Chongshan Chen



SHAHID ALAM  
PRIMARY EXAMINER